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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,758	06/08/2000	Gilbert Hu	017789-001000US	9887

7590

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EXAMINER

BUI, BING Q

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/590,758

Applicant(s)
Hu et al

Examiner
Bing Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 8, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al (U.S. Patent No. 6,014,427).

Regarding claim 1, with respect to Figures 1-2 and 3, Hanson et al teach a method for operating a telephone server (i.e., voice mail system "112") comprises:

receiving an incoming call from a caller (i.e., call from a user (voice mail service customer) associated with the "RECIPIENT TERMINAL 104"; see col. 3, lns 38 - 46);

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coupling the incoming call to a voice mail server (i.e., call from a user (voice mail service customer) associated with the "RECIPIENT TERMINAL 104" is received at the "VOICE MAIL SYSTEM CONTROLLER 108"; see col. 3, lns 38 - 46);

coupling the incoming call to a voice mail mailbox with the voice mail server (i.e., logging in the voice mail box system "112" by providing user's identification and valid password; see col. 3, lns 33 - 51);

receiving a request from the caller to initiate an outbound call (i.e., receiving the user's response together with sender address and unique action message ID that delivered to the "SERVICE CONTROLLER 202" for returning call to a message sender; see Fig. 5, step 526 and col. 7, ln 55 - col. 8, ln 1); and

saving a state of the voice mail server in response to the request (col. 4, lns 18 - 50).

receiving dialing instructions from the caller (i.e., receiving the user's response together with the sender address and unique action message ID that delivered to the "SERVICE CONTROLLER 202" for returning call to the message sender; see Fig. 5, step 526 and col. 7, ln 55 - col. 8, ln 1);

processing the dialing instructions to make the outbound call (i.e., the "SERVICE CONTROLLER 202" processes returning call to the message sender; see Fig. 5, step 526 and col. 7, ln 55 - col. 8, ln 1); and

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restoring the state of the voice mail server after the outbound call is terminated (i.e., after the step of returning call to the message sender as shown at step 526, the "SERVICE CONTROLLER 202" returns to initial step 518 to retrieve a next message to playback to the user; see col. 8, Ins 9 - 12).

Regarding claim 2, Hanson et al further teach the step of receiving the request from the caller to initiate the outbound call comprises:

detecting a series of DTMF tones from the caller (col. 4, Ins 18 -50 and col. 6, Ins 7 - 13);

determining the request in response to the series of DTMF tones (col. 4, Ins 18 - 50 and col. 6, Ins 7 - 13).

Regarding claim 3, Hanson et al further teach the step of receiving dialing instructions from the caller comprises detecting a series of DTMF tones from the caller (col. 4, Ins 18 -50 and col. 6, Ins 7 - 13).

Regarding claim 4, Hanson et al further teach the step of processing the dialing instructions comprises dialing the series of DTMF tones to make the outbound call (col. 4, Ins 18 -50 and col. 6, Ins 7 - 13).

Regarding claim 5, Hanson et al further teach:
wherein receiving dialing instructions from the caller comprises detecting a spoken phrase from the caller (col. 3, Ins 52 - 57 and col 6, Ins 7 -13); and

wherein processing the dialing instructions comprises:

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determining a telephone number associated with the spoken phrase; and
dialing the telephone number to make the outbound call (col. 3, Ins 52 - 57 and
col 6, Ins 7 -13).

Regarding claim 6, Hanson et al further teach the step of determining a
termination of the outbound call, wherein restoring the state of the voice mail server
comprises restoring the state of the voice mail server in response to the termination
(i.e., after the step of returning call to the message sender as shown at step 526, the
"SERVICE CONTROLLER 202" returns to initial step 518 to retrieve a next message to
playback to the user; see col. 8, Ins 9 - 12).

Regarding claim 7, Hanson et al further teach the step of providing a dial tone
to the caller in response to the request (col. 5, Ins 9 -30).

As to claims 8 - 13, they are rejected for the same reasons set forth to rejecting
claims 1-6 above, since claims 8-13 are merely a system for implementing the method
defined in the method claims 1-6, respectively.

As to claims 14 - 15, they are rejected for the same reasons set forth to
rejecting claims 1-2 above, since claims 14-15 are merely a system for implementing
the method defined in the method claims 1-2, respectively.

As to claim 16, it is rejected for the same reasons set forth to rejecting claims 3-
4 above, since claim 16 is merely a system for implementing the method defined in the
method claims 3-4.

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As to claims 17 - 18, they are rejected for the same reasons set forth to rejecting claims 5-6 above, since claims 17-18 are merely a system for implementing the method defined in the method claims 5-6, respectively.

As to claims 19 - 20, they are rejected for the same reasons set forth to rejecting claim 6 above, since claims 19-20 are merely a system for implementing the method defined in the method claim 6.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McElwee (US Pat No. 6,393,108) discloses a voice messaging system which allows a remote user to return a call without disconnecting from a telephone line.

Yue et al (US Pat No. 5,717,741) disclose method for handling telephone messages.

4.. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number

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for the organization where this application or proceeding is assigned is (703) 872-9314 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Mar 01, 2003



BING BUI
PATENT EXAMINER